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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------------|------------------|
| 10/088,719 | 06/19/2002 | Takako Fujii | M2096-4 | 5004 |
| 7278 | 7590 | 05/17/2005 | | |
| DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257 | | | EXAMINER WIEKER, AMANDA FLYNN | |
| | | | ART UNIT 3743 | PAPER NUMBER |

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/088,719 | FUJII ET AL. | |
| | Examiner | Art Unit | |
| | Amanda F. Wieker | 3743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 April 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2,7-9,13,14 and 25-41 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,2,7-9,13,14 and 25-41 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/19/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 April 2005 has been entered.

Allowable Subject Matter

2. The indicated allowability of claims 2, 7-9, 13-14 and 25-41 is withdrawn in view of the newly discovered issues under 35 U.S.C. 101.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2, 7-9, 13-14 and 25-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims reciting a portion of, or an attachment to, the human body contain non-statutory subject matter. 1077 OG 24 (April 21, 1987). "A claim directed to or including within its scope a human being will not be considered to be patentable subject matter under 35 U.S.C. 101". Accordingly, where a claim is directed to an apparatus "attached to" the human body or any part thereof, such a claim will be rejected under 35 U.S.C. 101, because the claim positively recites a part of the human body and therefore is directed to non-statutory subject matter.

Claims 1-2, 7-9, 13-14 and 25-41 recite an apparatus that is attached to a part of the human body. For example, in claim 1 Applicant recites (line 9) "the first portion covers a region extending from said position through tops of bulges of the buttocks". Claims reciting a portion of, or an attachment to, the human body contains non-statutory subject matter. Identical problems occur throughout the claims and should be carefully identified and corrected by Applicant.

Applicant can overcome this rejection by amending claim 1 to recite, "the first portion is adapted to covers a region extending from said position through tops of bulges of the buttocks", and making similar amendments to the remaining claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

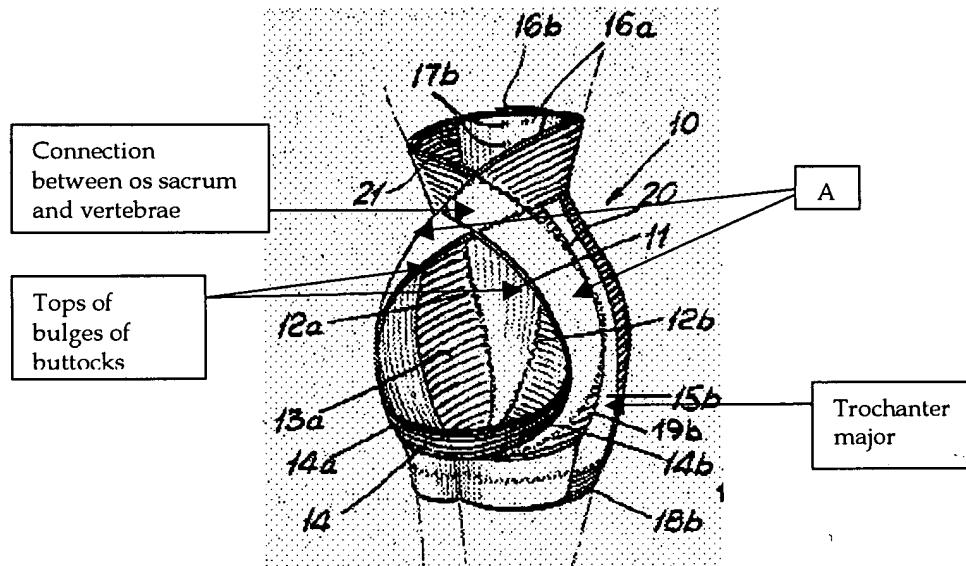
A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 3,756,247 to Hand.

Hand discloses a garment (10) comprising a stretch fabric wherein the garment covers at least a part of the lower body of a wearer, has a crotch part, and is worn by being fitted to the wearer's body, wherein: the garment in part has a portion with a strong straining force (14); the portion with a strong straining force is a strong straining portion (A); right and left parts of the portion (A) are connected at a position on the back side of the garment corresponding to any region from os sacrum to vertebrae lumbalis of the wearer's body (see figure below); and at

least part of the portion (A) covers a region extending from said position through tops of bulges of the buttocks in approximately a middle part of musculus gluteus maximus and approximately in the direction of muscle fibers of musculus gluteus maximus at right and left to at least the vicinity of trochanter major.



Response to Arguments

7. Applicant's arguments filed 12 April 2005 have been fully considered but they are not persuasive.

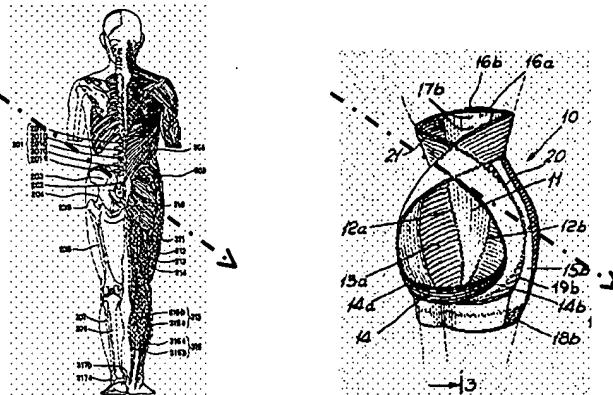
8. Initially, it is noted that while the allowability of claims 2, 7-9, 13-14 and 25-41 is withdrawn in view of the newly applied rejection under 35 U.S.C 101, the allowability of these claims based on prior art remains unchanged. The examiner regrets not having identified the errors under 101 earlier in prosecution.

9. Applicant's arguments (page 13) against the application of the Hand reference are wholly directed to the newly added limitation requiring the portion to cover a region extending from said position through tops of bulges of the buttocks in approximately a middle part of

musculus gluteus maximus and approximately in the direction of muscle fibers of musculus gluteus maximus at right and left to at least the vicinity of trochanter major. Applicant argues that Hand shows a band running “from the waist area to and around the periphery of the buttocks,” not “through tops of bulges of the buttocks in approximately a middle part of musculus gluteus maximus and approximately in the direction of muscle fibers of musculus gluteus maximus” as claimed.

The examiner disagrees. Despite Applicant’s amendment and arguments the examiner maintains that at least part of the first portion of Hand passes through the tops of the bulges of the buttocks in approximately the middle part of gluteus maximus. As shown by Applicant’s own Figure 71, the gluteus maximus is a large muscle extending outward and downward from the midline of a person. At least the innermost edge (i.e., toward the midline) portion of the Hand device passes through the tops of the bulges of the buttocks in approximately the middle of gluteus maximus.

Applicant also argues that the bands disclosed by Hand “do not cover the buttocks ‘in the direction of muscle fibers of musculus gluteus maximus’”. The examiner disagrees. Below is a side-by-side comparison of Applicant’s own Figure 71, and Figure 1 of Hand. A dashed line is drawn through the gluteus maximus muscle of Figure 71, in the direction of muscle fibers, and through the strong straining portion of Hand. Clearly, the strong straining portion extends at least “approximately in the direction of muscle fibers of musculus gluteus maximus at wearer’s right and left to at least the vicinity of trochanter major”.



Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

afw

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Amanda F. Wieker
Examiner
Art Unit 3743